

Remark:

The Final office action dated June 9, 2009 was carefully reviewed. It was found that the major differences between the applicant and the examiner is about the interpretation of the term "programming tool" and what are the requirements for a claim to be presented in order to satisfy the requirement of 35 U.S.C. 101?

(A) Position of the office action:

- (a) The office action (page 4, section 6 of office action 06/09/2009) interprets the subject matter of the subject claims "programming tool" to be an interface between programmers and computers (i.e. software) and therefore "programming tool" not a statutory class of invention.
- (b) The office action (page 4, section 6 of office action 06/09/2009) further indicated that the claim further fails to specifically recite claim limitations for components or physical structure to define or describe a machine or tangible device.
- (c) The office action (page 4, last paragraph of office action 06/09/2009) further indicated that the specification had defined the invention as a manipulation of specific data tables that represents logical thinking of a programmer, and therefore the invention is not a statutory class of invention.
- (d) The office action indicated that the steps recited in claims 92, 114, 120, 135, 148, 154, 170 and 175 are performed by a human (page 4 last paragraph of office action dated 06/09/2009), and therefore not statutory process.

(B) Position of the applicant:

In previous responses, the applicant had submitted that the subject claims are directed to "programming tool" which is defined to be a "machine" or any "structure" that enables a programmer to write programs for a computing device. Since the subject claims had already been directed to a "specific machine" commonly know as a "programming tool", according to the understanding of a person having ordinary knowledge in the art, therefore the subject claims had already satisfied the requirement of 35 U.S.C. 101.

(C) Comparing position (A)(a) with position (B) above:

Since the office action had interpreted "programming tool" as "software" and the applicant had interpreted the term "programming tool" as a machine, it is required to agree on how a term should be interpreted in a claim. The issue should be resolved as a matter of law.

- (a) It is necessary to determine if a pure "software" as interpreted by the office action is able to satisfy the requirement of the definition recited by the office action as "an interface between a programmer and computers". Obviously the interpretation of "programming tool" to be a pure software (without applying the software on a specific hardware) by the office action actually fails to be come a workable Interface between a programmer and a computer. This is a first evidence that the interpretation of the office action was erroneous because this interpretation directs to contradicting results. If the examiner insists on the interpretation that "programming tool" should be interpreted as a pure software, the examiner is respectfully requested to provide evidence how a "pure software"

without the hardware of "programming tool" can become a workable interface between a programmer and a computer?

- (b) The interpretation of a term should be conducted according to patent law. Listed below is a recitation of MPEP 2106 IIC; MPEP 2111.01 IV:

Toro Co. v. White Consolidated Industries Inc., 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) - Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

Listed below is how the definition of the term "programming tool" is specifically defined in the specification according to the understanding of a person having ordinary knowledge in the art:

According to the understanding of a person having ordinary knowledge in the art, a programming tool, as described herein, is defined as a "tool", a "machine", or any structure that enables a programmer to write different programs for a computing device.

Accordingly, the Final office action erred to force the applicant to accept a new definition (as a pure software) that was against the original intention of the subject claims. If the examiner declines to reverse the interpretation of the term "programming tool" to be a machine or structure, the examiner is required to provide evidence why the requirements of MPEP 2106 IIC and MPEP 2111.01 IV should not be followed in this case?

(D) Comparing position (A)(b) with position (B) above:

The office action questioned that if the claim language did not define the physical structure limitations of the claim subject "programming tool", then the term "programming

tool" cannot become a statutory matter. This is equivalent to asking an applicant to define the structural limitations of an "automobile" in claim language, in order to proof that an "automobile" is a statutory subject matter. This examination practice unfairly requires an applicant to further limit the claim scope of "automobile" or "programming tool" that is not desirable by the applicant. In fact, it is the desire of the applicant to have the claim scope to cover all different kinds of "programming tool" that enabling a programmer to program a computing device, as understood by a person having ordinary knowledge in the art. Alternately an "automobile" (as in the automobile case) should carry all different kinds of automobiles as understood by a person having ordinary knowledge in the art. Listed below is a quotation of MPEP 2173.04:

Breadth Is Not Indefiniteness

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

The patent law gives an applicant the right to broadly claim the scope of an invention. Similarly, breadth of a claim should not be limited in order to proof that a subject matter of a claim is statutory. Since the nature and scope of the subject machine, a "programming tool" is commonly understood by a person having ordinary knowledge in the art, and further that this term is precisely defined in the specification as a machine or structure to enable a programmer to program a computing device, the position of the office action to require reciting additional structural limitations of programming tool that unfairly limits the claim scope is respectfully requested to be withdrawn. If the examiner insists on the position that further structural limitations should be added into a claim scope in order to make an "automobile" or a "programming tool" (both machines clearly understood by persons having ordinary knowledge in the art) a statutory matter, the

examiner is respectfully requested to provide evidence where this requirement is presented in the patent law for an article to be a statutory matter?

(E) Comparing position (A)(c) with position (B) above:

The office action is correct that the specification describes a machine that is able to manipulate data tables that represents logical thinking of a programmer. This unusual capabilities of the machine distinguish the subject claimed "programming tool" from other different kinds of "programming tools" widely available in the market. The office action erred to refer the manipulation steps of specific data table as the subject matter of the subject claims. In fact, the claim language clearly recites the "programming tools", a machines to be the subject matter of the claims. The claims further recited limitations of the programming tool that it is structured to manipulate the specific types of data table are provided to distinguish the scope of the claimed programming tool as compared with other programming tool available in the market. The claim structure clearly recites a statutory subject matter – "programming tool", a machine commonly understood by a person having ordinary knowledge in the art, and as defined in the specification. The position of the office action to focus in treating the manipulation steps of data tables as subject matter is erroneous and respectfully requested to be withdrawn.

(F) Comparing position (A)(d) with position (B) above:

First of all, the office action erred to not recognize that without a machine known as a "programming tool", the human mentioned in the office action cannot use a "pure software" to program a computer. Secondly, the statement of the office action is equivalent to a statement that a special automobile that enables a user to operate

different seat configurations, or the process of steering the driving wheel of an automobile to make a turn are not statutory processes, because the seat configuration process or steering process are **"performed by human"**? Recent precedent court ruling In re Belski presented in the response dated 11/20/2008 set new standards to test compliance of 35 U.S.C. 101. In re Belski clearly indicated that a process is eligible for patent protection under 35 U.S.C. 101 if:

- (i) it is tied to a particular machine or apparatus; or
- (ii) it transforms a particular article into a different state or thing.

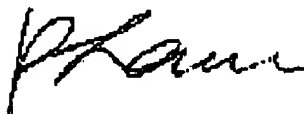
In the subject claims 92, 114, 120, 135, 148, 154, 170 and 175, both conditions are satisfied. The subject processes are tied to particular machines known as "programming tool" as understood by a person having ordinary knowledge in the art, and as defined in the specification. The subject process transforms a non-performing "unprogrammed" computer into a computer that runs according to the wish of a programmer, a process to transform an unprogrammed computing device into a programmed computing device. As proved in the situation of "automobile" above, weather if the claimed process requires human operation with the tied machine is **NOT** a condition set by the latest precedent court ruling In re Belski to define if a process is statutory. If the examiner insists that any process involving a human to operate on a machine is non-statutory, the examiner should provide law supported evidences that this requirement is valid.

As a summary, claim 86 directs a machine well known as a "programming tool" by a person having ordinary knowledge in the art as the subject matter of the claim. This machine – "programming tool" is clearly a physical machine that enables a programmer to program a computer (a "pure" software cannot be a "programming tool" according to

the definition provided). Since the applicant has provided law supported evidences that claim 86 directs to a physical machine named as "programming tool", the rejection of the final office action should be withdrawn unless the examiner is able to find law supported evidences to proof that the argument of the applicant in sections (C) to (F) above are wrong.

Since the final office action comprises of requirements and standards not supported by patent law, the final status of the subject office action is respectfully requested to be withdrawn. Furthermore, the above law supported evidences mentioned in sections (C) to (F) herein prove that the subject claims had already satisfied the requirement of 35 U.S.C. 101, full allowance of the subject claims is respectfully solicited.

Respectfully submitted by,



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** Recently the applicant is required to have frequent business trips to the Orient. He is easier to be reached by the email address lampeter@easyformat.com